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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,575	03/31/2004	Ilya Malyarov	2008P26174 US	4329
28524 7590 12/16/2008 SIEMENS CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 170 WOOD AVENUE SOUTH ISELIN, NJ 08830				
EXAMINER				
WRIGHT, PATRICIA KATHRYN				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
12/16/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/813,575

Applicant(s)

MALYAROV ET AL.

Examiner

P. Kathryn Wright

Art Unit

1797

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-17.
Claim(s) withdrawn from consideration: 18.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

Continuation of 11, does NOT place the application in condition for allowance because: of arguments of record. Further, in response to the previous rejection of claims 1-17 under 35 U.S.C. 102(b) as being anticipated by Babson et al. (US Patent no. 5,885,529), (hereinafter "Babson"), Applicant argues that Babson does not disclose a read station rotatable between an entry position and a read position, as recited in claim 1, but instead requires an element rotatable between an entry position of a wash station and a read position of a detector.

The Examiner respectfully disagrees. Claim 1 defines the read station solely in functional language (i.e., rotatable between the entry position and a read position). Applicant is reminded that apparatus claims must be structurally distinguishable from the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. There is no structure claimed that distinguishes the "read station" in claim 1 from the oval luminometer chain 215a of Babson, which rotates between an entry position (at the wash station 214) and a read position at a detector (photomultiplier tube (PMT)); (col. 8, line 31; Figs. 2a, 2b of Babson).

Applicant also argues that the claims do not encompass transporting vessels from a defined path of a transport device through a wash station into a read station, but require transport from a wash station to a defined path and from the defined path into a read station.

The Examiner respectfully disagrees with Applicant's argument. The analyzer of Babson includes a transport device 213b (side chain) for transporting a plurality of vessels 27 through a defined path. As stated in the last Official action at page 4, the transport device 213b receives the vessels from the wash station and transports the reaction tubes to reaction pipetting station 204 along a path defined by the side chain 213b. After reagent addition, the transport device (chain 213b) transfers the reaction from the path (chain 213b) to the wash station where the step of incubation and wash are repeated (see col. 8, lines 21-29) and into the read station (i.e., 215a) at the entry position. In other words, Babson teaches transport from a wash station to a defined path and from the defined path back into the wash station and into a read station. The open language of the claims do not preclude the transport device transferring the plurality of vessels from the defined path of the transport device and into the read station via the wash station 214.

Continuation of 13. Other: In response to the election by original presentation, Applicant argues that the claims are not distinct inventions just different in scope. Applicant also argues that the Examiner has not established there exists a serious burden by providing an example of different fields of search.

The Examiner respectfully disagrees the inventions of claims 1-17 and 18 are not distinct. New claim 18 requires a read station located between a detector and a transport device. This limitation is not required in claims 1-17. In addition, the read station of new claim 18 now includes the negative limitation of not accepting any other vessels at the entry position while a received vessel is in the read station. As discussed in the previous Official action at page 2, there is exist a search and examination burden at least for the reason that the prior art applicable to one invention would not likely be applicable to the other and would employ different search queries. There also exists an examination burden since the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph, at least for the reason that Applicant failed to cite where new claim 18 finds support in the original specification except to merely state that the new claim is fully supported by the original specification. See page 6 of the Remarks by Applicant filed June 11, 2008. Since applicant has received an action on the merits for the originally presented invention, this invention of claims 1-17 was constructively elected by original presentation for prosecution on the merits. See 37 CFR 1.142(b) and MPEP § 821.03.